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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,971	03/25/2004	Lawrence G. Ten Eyck	OM144	7059

26009 7590 02/04/2009

ROGER M. RATHBUN
13 MARGARITA COURT
HILTON HEAD ISLAND, SC 29926

EXAMINER	
LACYK, JOHN P	
ART UNIT	PAPER NUMBER
3735	
MAIL DATE	DELIVERY MODE
02/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,971	TEN EYCK ET AL.	
	Examiner	Art Unit	
	John P. Lacyk	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,9-32,34,35,38,41 and 43-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 9-32, 34-35, 38, 41, 43-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 9-32, 34-35, 38, 41, 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boone et al (2002/0196141) in view of Kraus et al (WO 02/45566).

Boone et al, as discussed previously, discloses a device or carestation that is used to monitor a patient using both environmental and physiological sensors that are integrated such that the combination of both are displayed on a display. Boone et al discloses the claimed device except for specifically teaching that the sensed signals are processed to provide the user with a “recommended course of action” based upon such sensed signals. Kraus et al discloses a similar device, that senses various parameters and teaches (page 51, lines 3-12) that the outputs of one or more signals are provided to the computer and display which can display diagnostic statements of different medical conditions as well as treatment recommendations. Therefore Kraus et al teaches that it is known to take such measurements and process them and determine a recommended treatment. Therefore a modification of Boone et al such that the sensed signals, both environmental and physiological, are processed and treatment recommendations or "a recommended course of action" Is provided to the display would have been obvious to one skilled in the art in view of the teachings of Kraus et al which

teaches that such an automated or computer generated recommended treatment or diagnosis is well known in the medical arts.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be "material to patentability as defined in 37 CFR 1.56."

The declaration filed 3/25/04 includes language stating "material to the examination …in accordance with 37 CFR 1.56(a)" , instead of material to the patentability … in accordance with 37 CFR 1.56.

Applicant's arguments filed 10/17/08 have been fully considered but they are not persuasive. Applicant argues that the device uses both physiological information and environmental information that is converted to a visual readout or display and that provides a recommended course of action to the user using both sources of information and that Boone in view of Kraus et al do not provide this. As stated in the rejection Boone does disclose using both physiological information and environmental information and providing a visual readout or display of both sources of information that is in a controlled environment. A caregiver would normally review all of the information displayed and provide a recommended course of action or diagnosis based upon the displayed readings. The only feature not specifically taught by Boone would have been taking the caregivers assessment and modifying it to an automated response by the

computer device. Kraus et al discloses a similar device and teaches using all of the sensed information and using the computer to provide an automated response that displays diagnostic statements of different medical conditions as well as treatment recommendations. Kraus et al was used as a teaching that it is known to take all the sensed information and using a computer be able to provide an automated diagnosis and recommended course of treatment. Therefore one of ordinary skill would have been motivated to modify Boone such that the computer would take all the sensed information (which would include both physiological and environmental information) and use the computer to provide any needed diagnosis and/or recommended course of action or treatment recommendations.

Applicant argues that Kraus et al is silent on using environmental conditions to provide a broader recommendation to the user, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As such the combined teachings would provide a modification of Boone such that **all** the information is

evaluated and a diagnosis and recommended treatment is provided, which would include any environmental information as well as any diagnosis and recommended treatment based upon readings from such environmental information.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is (571)272-4728. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Marmor, II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.P. Lacyk

/John P Lacyk/
Primary Examiner, Art Unit 3735